

THE HONORABLE _____

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

BLUCORA, INC., a corporation,

Plaintiff,

v.

MARK RICE, an individual, d/b/a
ZOOMANIA GAMES,

Defendant.

No. 13-1857

**COMPLAINT FOR DECLARATORY
JUDGMENT OF NON-INFRINGEMENT
OF TRADEMARK RIGHTS AND
OTHER RELIEF**

NATURE OF THE ACTION

1. This is an action for a declaratory judgment pursuant to 28 U.S.C. §§ 2201 and 2202. This action arises under the trademark and anticybersquatting laws of the United States, including 15 U.S.C. §§ 1114 and 1125(a), (c), and (d).

PARTIES

2. Plaintiff Blucora, Inc. ("Blucora") is a Delaware corporation with its principal place of business located at 10900 NE 8th Street, Suite 800, Bellevue, WA 98004.

3. On information and belief, Defendant Mark Rice, d/b/a ZooMania Games, is an individual residing and having his principal place of business at 114 Rockingham Way, Unit 5786, Ellijay, GA, 30540.

Complaint for Declaratory Judgment (No. 13-1857)

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JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction over this matter pursuant to 28 U.S.C. §§ 1331, 1332, 1338, 1367, and 2201. Blucora seeks a declaratory judgment under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, that its use and operation of its Zoo website, its registration and use of the zoo.com domain name, and its use and federal registration of the ZOO mark do not infringe or dilute any trademark rights that Defendant might own, constitute cybersquatting under the Anticybersquatting Consumer Protection Act, or constitute false designation of origin, unfair competition, or an unfair or deceptive trade practice under state or federal law, including the Lanham Act, 15 U.S.C. §§ 1114 and 1125(a), (c), and (d), or otherwise violate any rights Defendant might own. The amount in controversy exceeds \$75,000.

5. This Court has personal jurisdiction over Defendant because Defendant has purposefully availed himself of the benefits and protections offered by the state of Washington by conducting business in Washington, including marketing, holding out for sale, and selling goods within Washington; Blucora's claims arise out of (1) Defendant's use and asserted exclusive right to use certain marks in so conducting business in the state of Washington and (2) Defendant's efforts to have forfeited, cancelled, or transferred to him a domain name registered to, managed by, and used by Blucora to do business in the state of Washington; the existence of this dispute over trademark and related rights is impacting Blucora and its business in the state of Washington; and exercise of jurisdiction over Defendant comports with traditional notions of fair play and substantial justice.

6. Venue is proper in this Court under 28 U.S.C. § 1391(b), as this District is the district in which a substantial part of the events giving rise to the claims occurred and in which a substantial part of the property that is the subject of the action is situated. Defendant has asserted that Blucora, a corporation based in this District, has infringed Defendant's marks, which he uses in marketing, holding out for sale, and selling goods within, and otherwise doing business in, this

1 District; seeks to prevent Blucora, a corporation based in this District, from using and operating
2 its Zoo website, registering and using the zoo.com domain name, and/or using or maintaining its
3 federal registration of the ZOO mark; and seeks to have forfeited, cancelled, or transferred to
4 him the zoo.com domain name, the rights to which are held in this District by Blucora, a
5 corporation based in this District.
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10 11 12 **PERTINENT FACTS**

13 14 **Blucora's Zoo Website, zoo.com Domain Name, and ZOO Mark**

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17 7. Since the late 1990s, Blucora has owned and operated the Zoo website at the
18 domain name zoo.com, from which it offers search engine and other related computer services.
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21 8. Blucora is the registrant for, and controls the registration and use of, the domain
22 name zoo.com, which it uses in connection with the Zoo website.
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25 9. In connection with the Zoo website and zoo.com domain name, Blucora does not
26 and has never offered any services specifically relating to animals or zoological gardens or the
27 keeping or display of animals. In connection with the Zoo website and zoo.com domain name,
28 Blucora does not offer and has never offered any computer services relating to the business of
29 creating, selling, marketing, and distributing games, including zoological garden-themed games
30 for children and adults.
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37 10. In connection with the Zoo website and zoo.com domain name, Blucora owns
38 USPTO Registration Number 3,373,136 for the ZOO mark for use in connection with "computer
39 services, namely, providing search engines for obtaining data on a global computer network,
40 creating indexes of information, sites, and other resources available on computer networks for
41 others; searching and retrieving information, sites, and other resources available on computer
42 networks by way of search engines, all of the above not including any services specifically
43 relating to animals or zoos or the keeping or display of animals," issued to Blucora on January
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22, 2008. A true and correct copy of this USPTO registration is attached hereto as Exhibit A and fully incorporated herein.

Defendant's Zoological Garden-Themed Games, Business, and Marks

11. Defendant does business as ZooMania Games. According to Defendant's ZooMania Games website, posted to the domain names zoomania.com and zoomaniagames.com, ZooMania Games is in the business of creating and selling illustrated, zoological garden-themed "children's games incorporat[ing] learning development opportunities including social skills, numbers, counting, animal recognition, colors and letters." ZooMania Games' children's game and/or toy offerings include Zoo Party, Zoo Playing Cards, Top Banana, Dawgs, Space Dogs, Under the Sea, The Great Bug Hunt, DOS Twice the Fun, The Game Of ZOO, Zoofari, Funky Monkeys, and The Great Bug Hunt. ZooMania Games also sells adult party games, including Elephonkey and iPresident.

12. Defendant purports to own various trademark rights, including federal registrations, for the marks ZOO (for use in connection with "card games"), ZOO MANIA (for use in connection with "equipment sold as a unit for playing card games"), ZOOFARI (for use in connection with "parlor games"), ZOO PALS (for use in connection with "parlor games"), ZOO PARTY (for use in connection with "parlor games"), ZOO MANIACS (for use in connection with "parlor games"), and ZOO GAMES (for use in connection with "parlor games") (collectively, "Defendant's Marks").

13. Blucora's services offered in connection with its ZOO mark do not compete with Defendant's goods and services offered in connection with Defendant's Marks.

14. Since Blucora began operating the Zoo website at the zoo.com domain name and offering its services under the ZOO mark, it has never been made aware of a single incidence of confusion on the part of the public between Blucora, its services, and its marks and Defendant, his goods and services, and Defendant's marks.

Defendant's Allegations of Infringement and Cybersquatting

15. On July 25, 2012, Defendant sent an infringement and cybersquatting notice to Blucora asserting that Blucora's use of the ZOO mark, its registration and use of the zoo.com domain name, and its operation of the Zoo website at that domain name infringed Defendant's rights under Defendant's Marks and constituted cybersquatting. The notice states:

I understand that you have registered and use a ZOO domain name. Absent an agreement with me, the use, marketing, and promotion of a ZOO trade name would constitute unfair competition and trademark infringement in violation of Section 43(a) of the Lanham Act, 15 U.S.C. 1125(a) et. seq. as well as various common law causes of action.

.....

Although you use a domain name, it is nonetheless identical to my product's name for purposes of the likelihood of confusion analysis

It is apparent that your use of the domain name ZOO is nothing more than a typical cyber squatting situation that is fully addressed by the [Anticybersquatting Consumer Protection Act]

A true and correct copy of the infringement and cybersquatting notice Defendant sent Blucora is attached hereto as Exhibit B and fully incorporated herein.

16. On December 27, 2012, Defendant filed a Petition to Cancel Blucora's USPTO registration for the ZOO mark with the Trademark Trial and Appeal Board ("TTAB"). A true and correct copy of the Petition to Cancel is attached hereto as Exhibit C and fully incorporated herein.

17. On March 13, 2013, Blucora and Defendant participated in a discovery conference. At that conference, Defendant (1) expressed his belief that Blucora's use of the ZOO mark, its registration and use of the zoo.com domain name, and its operation of the Zoo website at that domain name infringed Defendant's rights under Defendant's Marks, (2) represented that the only acceptable outcome of the dispute he initiated in the TTAB was for Blucora to abandon its registration for the ZOO mark and to transfer registration of the zoo.com

1 domain name to Defendant; and (3) indicated that, if the TTAB were to grant his Petition to
 2 Cancel, he would file a lawsuit against Blucora in federal district court alleging cybersquatting
 3 and seeking an order requiring Blucora to transfer registration of the zoo.com domain name to
 4 Defendant. Defendant made similar threats, implicitly and explicitly, in other communications
 5 with Blucora in connection with this dispute.
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10 18. On April 29, 2013, Blucora moved for partial summary judgment on Defendant's
 11 claims in the TTAB. In opposition, Defendant filed a declaration in which he declared, *inter*
 12 *alia*:
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 17 In 2011, I had become aware of a domain web site which was
 18 accessed via the address www.zoo.com. . . . On said site, . . .
 19 [t]here was no information nor trademark notations, no R or TM
 20 found anywhere on the site. I had determined that said domain
 21 was a site that would cause likelihood of confusion with my ZOO
 22 theme and the multitude of [my] products that were promoted and
 23 advertised with the ZOO theme.
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25 A true and correct copy of this declaration is attached hereto as Exhibit D and fully incorporated
 26 herein.
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28 19. On September 30, 2013, Blucora, in an attempt to resolve the TTAB dispute with
 29 Defendant, sent to Defendant for his signature a signed voluntary surrender of its federal
 30 registration for the ZOO mark with consent.
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33 20. Defendant did not consent but instead responded in part as follows:
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 37 I will review and get back to you this week. Should we discuss
 38 options relating to how best to resolve the domain issue? If your
 39 client takes a position that there exists no claims, then I can
 40 proceed with taking this to the next level.
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42 21. When asked by Blucora to clarify the meaning of "taking this to the next level,"
 43 Defendant responded in part as follows:
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 46 The Petition to the USPTO was what I would consider the first step
 47 in evaluating those options. . . . If Blucora is assuming that our
 48 dispute ends with the Petition, I cannot assure you of that
 49 assumption being correct. . . . I do not think this matter is over.
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1 A true and correct copy of this exchange is attached hereto as Exhibit E and fully incorporated
2 herein.
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4 22. Blucora refuses to cease operating the Zoo website, refuses to transfer registration
5 of the zoo.com domain name to Defendant, and now refuses to abandon its federal registration
6 for the ZOO mark.
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10 23. There is an actual controversy between Blucora and Defendant, and Blucora has a
11 reasonable apprehension that Defendant will sue Blucora for trademark infringement, trademark
12 dilution, cybersquatting, and/or related claims under state and federal laws.
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16 **REQUEST FOR DECLARATORY JUDGMENT**

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18 24. Blucora incorporates and re-alleges the matters set forth above.
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20 25. There is a justiciable dispute between the parties as to whether Blucora's use and
21 operation of its Zoo website, registration and use of the zoo.com domain name, and federal
22 registration and use of the ZOO mark infringe or dilute any trademark rights that Defendant
23 might own, constitute cybersquatting under the Anticybersquatting Consumer Protection Act, 15
24 U.S.C. § 1125(d), constitute false designation of origin, unfair competition, or an unfair or
25 deceptive trade practice under state or federal law, including the Lanham Act, 15 U.S.C. §§ 1114
26 and 1125(a) and (c), or otherwise violate any rights Defendant might own.
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37 26. Defendant's Marks, including the ZOO mark, are not inherently distinctive, have
38 not acquired a high degree of distinctiveness, and are not famous. The term "zoo" is a common,
39 inherently descriptive English language term used by numerous third parties for a variety of
40 branding and fair use purposes.
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44 27. Blucora used and uses the Zoo website, the zoo.com domain name, and the ZOO
45 mark in connection with and to further legitimate business purposes.
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48 28. Blucora's use and operation of its Zoo website, registration and use of the
49 zoo.com domain name, and federal registration and use of the ZOO mark do not and will not:
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- a. Infringe any of Defendant's trademark rights under 15 U.S.C. §§ 1114 or 1125(a) or any other state or federal law;
- b. Cause dilution of Defendant's Marks under 15 U.S.C. § 1125(c) or any other state or federal law;
- c. Constitute false designation of origin under 15 U.S.C. § 1125(a) or any other state or federal law;
- d. Constitute cybersquatting under 15 U.S.C. § 1125(d) or any other state or federal law;
- e. Constitute unfair competition under 15 U.S.C. § 1125(a) or any other state or federal law;
- f. Constitute an unfair or deceptive trade practice under 15 U.S.C. § 1125(a) or any other state or federal law; or
- g. Otherwise violate any rights Defendant might own.

29. Blucora is entitled to a declaratory judgment that Defendant's Marks are not famous and that Blucora's use and operation of its Zoo website, registration and use of the zoo.com domain name, and federal registration and use of the ZOO mark do not and will not:

- a. Infringe any of Defendant's trademark rights under 15 U.S.C. §§ 1114 or 1125(a) or any other state or federal law;
- b. Cause dilution of Defendant's Marks under 15 U.S.C. § 1125(c) or any other state or federal law;
- c. Constitute false designation of origin under 15 U.S.C. § 1125(a) or any other state or federal law;
- d. Constitute cybersquatting under 15 U.S.C. § 1125(d) or any other state or federal law;
- e. Constitute unfair competition under 15 U.S.C. § 1125(a) or any other state or federal law;

- 1 f. Constitute an unfair or deceptive trade practice under 15 U.S.C.
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3 § 1125(a) or any other state or federal law; or
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5 g. Otherwise violate any rights Defendant might own.
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8 **PRAYER FOR RELIEF**
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10 WHEREFORE, Blucora prays for the following relief:
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12 A. A declaratory judgment that Blucora's use and operation of its Zoo website,
13 registration and use of the zoo.com domain name, and federal registration and use of the ZOO
14 mark do not and will not:
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- 18 1. Infringe any of Defendant's trademark rights under 15 U.S.C. §§ 1114 or
19 1125(a) or any other state or federal law;
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21 2. Cause dilution of Defendant's Marks under 15 U.S.C. § 1125(c) or any
22 other state or federal law;
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24 3. Constitute false designation of origin under 15 U.S.C. § 1125(a) or any
25 other state or federal law;
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27 4. Constitute cybersquatting under 15 U.S.C. § 1125(d) or any other state or
28 federal law;
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30 5. Constitute unfair competition under 15 U.S.C. § 1125(a) or any other state
31 or federal law;
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33 6. Constitute an unfair or deceptive trade practice under 15 U.S.C. § 1125(a)
34 or any other state or federal law; or
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36 7. Otherwise violate any rights Defendant might own.
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45 B. A preliminary and permanent injunction prohibiting Defendant, his affiliates,
46 agents, servants, employees, and attorneys, and any and all other persons in active concert or
47 participation with them, from improperly interfering with Blucora's business, including from
48 asserting that Blucora's use and operation of its Zoo website, its registration and use of the
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Complaint for Declaratory Judgment (No. 13-1857)

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1 zoo.com domain name, and its use and federal registration of the ZOO mark infringe or dilute
2 any trademark rights that Defendant might own, constitute cybersquatting under the
3 Anticybersquatting Consumer Protection Act, constitute false designation of origin, unfair
4 competition, or an unfair or deceptive trade practice under state or federal law, including the
5 Lanham Act, 15 U.S.C. §§ 1114 and 1125(a), (c), and (d), or otherwise violate any rights
6 Defendant might own.
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- 12 C. An award of attorneys' fees and costs to Blucora to the extent permitted by law;
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14 D. An immediate order staying Defendant's Petition to Cancel action in the TTAB;
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16 E. Such further and other relief as the Court deems just and proper.
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21 DATED: October 15, 2013

22 By: s/ William C. Rava
23 By: s/ James L. Vana
24 By: s/ Catherine S. Simonsen
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